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EXAMINER

RAMAN, USHA

ART UNIT PAPER NUMBER

2616

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,957

Applicant(s)

KNEPPER ET AL.

Examiner

Usha Raman

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7-9-01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, 4-7, 11-14, 16-17, 20-22, 27-30, 70-76, 80-83, 89-90, 92-94 rejected under 35 U.S.C. 102(e) as being anticipated by Khoo et al. (US Pat. 6,434,747).

In regards to claim 1, Khoo teaches a method of displaying content media files comprising the steps of, delivering customized media (entertainment and advertisement media) and storing at client storage system, , pursuant to an instruction set (customized media list) received from a server, assembling at the client the first media files and at least one of the second media files to form a continuous show; and playing the show as a single continuous play. See column 2, lines 45-53. lines 66-67, and column 4, lines 1-5.

In regards to claim 2, Khoo discloses the step of displaying the customized media on a display screen. See column 3, lines 8-10.

In regards to claim 4, Khoo discloses that customized media comprise advertisement and television shows.

In regards to claims 5, 6 and 7, Khoo discloses that the customized media can be audio, visual or television signals. See column 9, 58-63.

In regards to claim 11, Khoo discloses that the customized media list is generated based on user's personalized data (behavior statistics). See figure 5 and step 625 in figure 6. The customized media content delivered is therefore in accordance with user behavior statistics.

In regards to 12, and 13, Khoo discloses maintaining user behavior statistics (241) comprising personalized data about user such as user viewing habits (therefore tracking information indicating which media files are played at the user site) and delivering to the server (to user management module 320) by client. See column 6, lines 43-47.

In regards to claim 14, Khoo discloses that the server having a set of first media files delivered therefrom, the server having a set of second media files delivered therefrom, and the server having an instruction set received therefrom comprise the same single server (225).

In regards to claim 16, Khoo discloses the steps of delivering and storing customized media (comprising of advertisement and television show) at the client storage, and therefore teaches the steps of pre-caching a plurality of entertainment media files at a client side; pre-caching a plurality of advertising media files at the client side (see column 3, lines 2-5 and column 2, lines 52-53); providing insertion indications (i.e. media clip ordering information) indicating where the entertainment media files may have advertisement media files inserted therein (see column 7, lines

32-36); providing association indications (i.e. properties of content media) indicating the types of advertisement media files that should be associated/correlated with the entertainment media files (see column 7 lines 49-54); receiving from the client a command to play one or more of the pre-cached entertainment media files; and sending to the client a text file (customized medial list), the text file including instructions embedded therein, the instructions directing the client regarding the entertainment media files and the advertising media files to be assembled together, and in what order, for playback with the appearance of a single media file (see column 7, lines 32-36).

In regards to claim 17, see claim 2.

In regards to claim 20, Khoo discloses that association indications (content properties used to associate commercials with entertainment media files) are contained within the entertainment media files (see column 7, lines 49-54).

In regards to claim 22, Khoo discloses providing insertion (i.e. playback order) indication for the customized media list by indicating its placement in a customized medial list (i.e. text file). See column 7, lines 32-36.

In regards to claim 27, see claim 5.

In regards to claim 28 see claim 6.

In regards to claim 29, see claim 7.

In regards to claim 30, Khoo discloses that sending text file is concurrent with storing the customized media content (see column 7, lines 20-26).

In regards to claim 70, Khoo discloses the step of displaying multiple files at a client side by delivering multiple media files (customized media files) to a client side from a server, pursuant to an instruction set (customized media list) arranging on the client side, the selected media files and playing the arranged media files as a continuous show. See column 3, lines 1-10, and column 7, lines 29-36.

In regards to claim 71, the customized media list is delivered from client side to the server side. See column 2, lines 58-67.

In regards to claim 72, the multiple media files comprises entertainment media files. See column 2, lines 21-26.

In regards to claim 73, see claim 4.

In regards to claim 74, see claim 5.

In regards to claim 75, see claim 6.

In regards to claim 76, see claim 7.

In regards to claim 80, Khoo discloses a client system programmed to receive advertisement and content media files (customized media files), and assemble (via order determined by the customized media list) the at least one advertisement media files and entertainment as a continuous show. See column 3, lines 1-10, and column 7, lines 29-36.

In regards to claims 81 and 83, Khoo discloses that the customized media list comprises a predetermined playback order of plurality of advertisement and entertainment programs in accordance with viewer characteristics. Therefore it is within the scope of the Khoo's invention that an advertisement file be positioned in between an entertainment media files.

In regards to claim 82, Khoo discloses a server system connected to the client over an Internet (therefore the server comprises a hosting means to host a web server) to deliver advertisement and content media files (customized media files) to the client, and an instruction set (customized media list) that instructs the client how to assemble the at least one advertisement media files as a continuous show. See column 3, lines 1-10, column 4, lines 24-34, and column 7, lines 29-36.

In regards to claim 89, see claim 4.

In regards to claim 90, Khoo discloses downloading all the customized media from the customized list, and therefore discloses showing all of the advertisement media files.

In regards to claim 92, see claim 5.

In regards to claim 93, see claim 6.

In regards to claim 94, see claim 7.

3. Claims 51-59, 60-61 and 63-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond et al. (US Pat. 6,698,020).

In regards to claim 51. Zigmond discloses the step of delivering a plurality of advertisement media files to a client across a communications network for storage at the client, the advertisement media files defining a client library (86); receiving a request from a user at the client to deliver a media object to the client (such as a pay per view request); modifying the client library (the server periodically updates ad repository to reflect changing advertisements in content provider database as well as to reflect changing viewer preferences, see column 16, lines 2-16); and in response to the request, delivering the media object to the client for playback together with at least some of the advertisement media files from the client library. See abstract, column 18, lines 35-37.

In regards to claim 52, when the server periodically downloads advertisements into the client library, the modification is based upon a criteria provided by the supplier of the media object. See column 16, lines 2-16.

In regards to claim 53, 54, and 55, Zigmond discloses that advertisement content can be audio, image file or a video file. See column 9, lines 1-14.

In regards to claim 56 and 57, Zigmond teaches the step of delivering content files and advertisements in response to a user request for events such as a pay per view movie. See column 18, lines 29-36. Therefore the system allows the user to make a request for a content item, such as pay per view movie, and deliver media content and advertisement

files related to the user requested program. In order for a content provider to service a user request for services such as pay per view, movies with no commercial interruptions, the request the "premium" type services has to be derived from user subscription of some form.

In regards to claim 58, Zigmond discloses pre-filtering advertisements in the client repository in accordance with ad selection criteria (which are reflective of user behavior statistics). See column 15, lines 17-23.

In regards to 59, Zigmond discloses collecting user statistics and transmitting to server by client. See column 9, lines 39-55.

In regards to claim 60, Zigmond discloses that it is well known to deliver content object having a plurality of predefined advertisement slots and only some of the slots are selected for playing the substituted ads in. See figures 2A, 2B.

In regards to claim 61, Zigmond discloses the methods of utilizing existing advertisement slots as delivered by the content provider or completely disregarding the original advertisement slots, and thus its own slots on a "pseudo random" basis by pausing and resuming the primary content. See column 16, lines 31-43.

In regards to claim 63, Zigmond discloses that an ad designation can comprise a predefined category of advertisement to be included during playback of an entertainment file. See column 12, lines 53-59.

In regards to claim 64, Zigmond teaches the step of using negative associations so that a particular advertisement is not correlated with a program content (for example an R rated commercial may not be included in a G rated program). See column 13, lines 48-58.

In regards to claim 65, 66 and 67, see claims 53, 54, 55

In regards to claim 68, Zigmond discloses that advertisements are selected at the user site in accordance with user behavior characteristics used in ad selection criteria. See column 13, lines 12-14.

In regards to claim 69, Zigmond discloses that user behavior statistics are collected stored and delivered to server by client. See column 9, lines 39-55.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 15, 19 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khoo et al. (US Pat. 6,434,747).

In regards to claim 15, Khoo does not disclose that the server sending media files (210), the server sending second media files (210)

and the server sending an instruction set (226) comprise multiple servers. Examiner takes official notice that it is well known to employ a plurality of servers to handle each of the functionalities above. It would have been obvious to modify the system of Khoo by employing a plurality of servers, each for delivering advertisements, media content and customized media instruction. The motivation is to specialize the task handled at each server, thus optimizing the functionality of each of the servers (for example, optimize for I/O data throughput, or database search retrieval).

In regards to claim 19, Khoo only discloses providing insertion indications in the custom media list, indicating the playback ordering of the advertisement and media content. Khoo does not disclose insertion indications contained within the entertainment files. Examiner takes official notice that it is well known to include triggers (insertion points for ads) in entertainment files. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system to include trigger points in entertainment files. The motivation is to allow content provider dictate the insertion indications for inserting advertisements and other secondary data into the primary content.

In regards to claim 31, Khoo discloses association indications for correlating advertisements to content media. See column 7, lines 37-61. Khoo does not disclose association indications that indicate types of advertisement that cannot be inserted in an entertainment media file. Examiner takes Official Notice that it is well known to use negative

associations in order to negatively correlate an advertisement to a media file. For example, when the primary video content is a children's video indicate, there might be an association indication for negatively associating an alcohol commercial. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system to include negative associations for negatively correlating advertisements that are inappropriate to be included with certain program types.

6. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US Pat. 6,698,020).

In regards to claim 62, the system does not disclose defining a maximum number of advertisement files that can be inserted in the content object. Examiner takes official notice that it is well known to establish an upper limit on the number of commercials a program can have, in order to prevent too many interruptions of the content program. It would have been obvious to one of ordinary skill in the art at the time of the invention to establish an upper limit on the number of commercials that can be inserted in a program, in order to prevent too many interruptions.

7. Claims 3, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khoo in view of Bhagavath (US Pat. 6,505,169)

In regards to claims 3 and 18, Khoo does not disclose displaying primary content in a first display area and displaying advertisements in a second display area of the display screen. Bhagavath discloses streaming programming content in a first display area and advertisement

as banners in a second display area of the screen, in order to present the advertisement without interrupting the streaming program content. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Khoo in view of Bhagavath's teachings by displaying advertisements in a second display area of the screen, thereby presenting advertisements to user without interrupting the play of the first content.

8. Claims 8-10, 21, 23-26, 77-79, 84-88, and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khoo et al. (US. 6,434,747) In view if Zigmond et al. (US Pat. 6,698,020).

In regards to claim 8, 9, and 10, Khoo does not disclose that the content media files are delivered to the client in response to user request. Zigmond teaches the step of delivering content files and advertisements in response to a user request for events such as a pay per view movie. See column 18, lines 29-36. It would have been obvious to one of ordinary skill in the art to modify the system to allow the user to make a request for a content item, such as pay per view movie, and deliver media content and advertisement files related to the user requested program. The motivation is to allow user to request for video content, thus enhancing viewer experience. In order for a content provider to service a user request for services such as pay per view, movies with no commercial interruptions, the request the "premium" type services has to be derived from user subscription of some form.

In regards to claim 21, Khoo only teaches the step of first receiving a customized media file (text file) and then accepting a play command and therefore lacks the step of transmitting a text file in response to a play command. Zigmond teaches the step of requesting play of an entertainment media, and in response to that receiving ad selection criteria that indicates what ads to place in the entertainment media. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Khoo in view of Zigmond's teachings by first allowing a user to select a program content and then create a customized media list for that program content. The motivation is to allow a user to have control over what entertainment file to play rather than receiving a server recommended entertainment media file.

In regards to claim 23, Khoo teaches using an "absolute" correlation method for correlating advertisement and entertainment media in a customized media list and does not disclose using association with the text files. Zigmond teaches the step of using association indicators in the ad selection criteria, so that ads can be correlated to programs using various criteria thereby creating flexibility in what can be presented to the viewer (for example, a given ad can be overridden due to its rating, category type, etc.) . It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Khoo in view of Zigmond's teachings by including association indicators in the text file,

thereby providing added flexibility in the presentation of the continuous media.

In regards to claim 24, see claim 8.

In regards to claim 25, see claim 9.

In regards to claim 26 see claim 10.

In regards to claim 77, see claim 8.

In regards to claim 78, see claim 9.

In regards to claim 79, see claim 10.

In regards to claim 85, see claim 8.

In regards to claim 86, see claim 9.

In regards to claim 87, see claim 10.

With regards to claim 84 and 88, Khoo does not disclose the step of pre-caching advertisement files before the entertainment clips are delivered. Zigmond teaches the step of pre-caching a plurality of advertisement files before the delivery of entertainment clips. It would have been obvious to one of ordinary skill in the art to modify the system of Khoo in view of Zigmond's teachings by pre-caching the advertisements prior to delivery of the entertainment clip. The motivation is to enable the client device to download advertisements during off peak traffic and use the custom media list to assemble advertisements with entertainment media upon the delivery of the entertainment clip for continuous show presentation.

In regards to claim 91, Khoo does not comprise showing fewer than all advertisement files. Zigmond discloses the step of selecting fewer advertisements for correlation and playback than that are cached in the advertisement media files. It would have been obvious to one of ordinary skill in the art to modify the invention of Khoo with Zigmond's teachings by showing fewer than all advertisement segments, thereby providing a viewer less interruptions.

9. Claims 32-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US Pat. 6,698,020) in view of Khoo et al. (US Pat. 6,434,747).

In regards to claim 32, Zigmond discloses a method for providing entertainment combined with advertising, comprising: delivering a plurality of advertisement media files from a server (62) to a client (60) across a computer network for caching at the client (86), and delivering both an entertainment file and an advertising designation to the client, the entertainment file and the advertising designation being associated together such that the client will combine both the entertainment file and selected advertisement media files from the menu of cached advertisement media files (ad selection criteria), for playback together. See column 11, lines 30-49.

Zigmond does not disclose the step of the cached advertisement media files defining a menu of cached advertisement media files. Khoo discloses

the step of providing a customized list that defines a "menu" of all the cached customized media files.

It would have been obvious to one of ordinary skill in the art to modify the system of Zigmond in view of Khoo's teachings by providing a "menu" means in the form of a media list, that defines all the media files pre-cached at the client system. The motivation is to allow the user to access and manipulate the client media-database via a menu.

In regards to claims 33 and 34, see claim 3.

In regards to claim 35, Zigmond discloses the step of selecting fewer advertisements for correlation and playback than that are cached in the advertisement media files.

In regards to claims 36, 37 and 38, see claims 8-10.

In regards to claim 39, and 41, Khoo discloses the step of providing the client with the option of modifying the customized list (thereby giving the user the opportunity to modify the advertising designation during playback of a clip or prior to the start of the next clip in the customized media list of customized media. See figure. 6, and column 6, lines 43-53

In regards to claims 40 and 42, Khoo (US Pat. 6,434,747) discloses the step of providing the client the option to modify the customized media list.

In regards to claims 43, Zigmond discloses that playback of advertisements can be modified based on other category of an advertisement that has been played back (for example a car manufacturer

may preclude other car advertisements from playing during a program.

See column 14, lines 14-23.

In regards to claim 44, Khoo discloses that the advertisement files indicated in the customized list are generated by the server and delivered to the user.

In regards to claim 45, an advertisement media file is selected to be included in a customized media list in response to a ad selection criteria (i.e. correlation of the user and a criteria contained within the ad designation. See Khoo, column 2, lines 38-53.

In regards to claim 46, Zigmond discloses that an ad designation can comprise a predefined category of advertisement to be included during playback of an entertainment file. See column 12, lines 53-59.

In regards to claim 47, the selected advertisement media files are selected at least in part by the server are indicated in a custom media list generated by the server, and the advertisement files selected by the client are indicated by the modified custom media list.

In regards to claim 48, see claim 5.

In regards to claim 49, see claim 6.

In regards to claim 50, see claim 7.

Conclusion


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number

is (571) 272-7380. The examiner can normally be reached on Mon-Fri:
9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful,
the examiner's supervisor, Andrew Faile can be reached on (571) 272-
7375. The fax phone number for the organization where this application
or proceeding is assigned is 703-872-9306.

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